

REMARKS

The Office Action mailed October 31, 2005 has been carefully reviewed along with the references cited therein. In the Office Action, the Examiner rejected claims 1-10, and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) (FIG. 2) in view of Patel (U.S. Patent No. 6,163,073), further in view of Winkler (U.S. Patent No. 4,705,934).

In rejecting independent claims 1 and 17, the Examiner indicated that even though AAPA lacks an additional switch being mounted on a first surface, it would have been obvious to a person of ordinary skill in the cooling art to place one of the switches of Winkler adjacent to the switch (Q1) of AAPA to provide a switching system to control system output power in an arc welder. The Examiner has failed to establish prima facie for the pending claims because she lacked a proper motivation to combine AAPA and Winkler. The Examiner's motivation to combine Winkler with AAPA appears to be based on either a misunderstanding of Winkler or on an impermissible use of applicant's disclosure. As for the misunderstanding of Winkler, the Examiner indicated that Winkler discloses a plurality of switches 1-5 mounted between a first surface (A) and a second surface (B). The figure in Winkler is a schematic circuit diagram of an arc welder. Reference characters A and B refer to leads and not to surfaces, as the Examiner suggests. Since Winkler does not disclose placing a plurality of switches on a surface, the only other location for a motivation to provide more than one switch on a surface is Applicant's disclosure. Knowledge of Applicant's disclosure, however, must be put aside in reaching an obviousness determination. MPEP § 2142.

Winkler and AAPA cannot be properly combined for additional reasons. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. AAPA already teaches the use of multiple switches Q1 and Q2 to control system output power in an arc welder. Winkler, however, fails to teach or suggest placing any of switches 1-5 on a heat sink. The only instance in Winkler where heat dissipation is discussed is with regard to diode 6 – not with regard to any of the switches. (See col. 6, lines 38-43) One of ordinary skill in the art would not modify a reference that discloses one switch per heat dissipating member, i.e. AAPA, with a reference that merely discloses a plurality of switches that are never mentioned as being mounted on any heat

dissipating member. There is simply no motivation. Accordingly, neither Winkler nor AAPA suggest the desirability of the claimed heat dissipation platform for output switches.

The Examiner erred when combining AAPA and Winkler, and therefore has failed to establish prima facie obviousness with regard to the pending claims. Accordingly, Applicant respectfully asserts that all pending claims define over the cited references and are in condition for allowance.

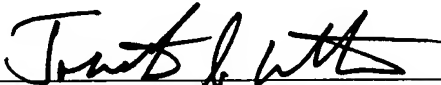
CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application are now in condition for allowance. Accordingly, an early indication of the same is earnestly solicited. In any event, should the Examiner consider personal contact advantageous to the disposition of this case, she is encouraged to telephone the undersigned at the number listed below.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP.

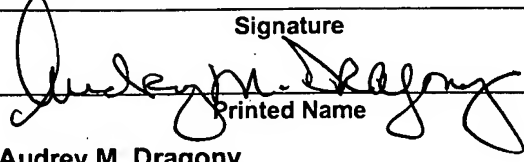
January 31, 2006
Date


Robert V. Vickers, Reg. No. 19,504
Jonathan A. Withrow, Reg. No. 54,548
1100 Superior Avenue, Seventh Floor
Cleveland, OH 44114-2579
216-861-5582

CERTIFICATE OF MAILING OR TRANSMISSION

Under 37 C.F.R. § 1.8, I certify that this Amendment is being

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